

### REMARKS

Applicant respectfully directs the Examiner's attention to note that no record has been received regarding acknowledgment of the Information Disclosure Statement (IDS) electronically filed July 31, 2002. Acknowledgement of the references cited therein is respectfully requested. Furthermore, Applicant respectfully directs the Examiner's attention to an IDS filed April 06, 2004 based on a foreign search report. Acknowledgement of the references cited therein is respectfully requested.

### *Election/Restrictions*

Claims 1-4 and 10-17, drawn to a magnet assembly, classified in class 234, subclass 319 and Claims 5-9 and 18-25, drawn to a method of optimizing an actively shielded magnet, classified in class 324, subclass 322 have been restricted. Claims 1 - 4 and 10 - 17 have been elected for prosecution. Claims 5 - 9 and 18 - 25 have been withdrawn from consideration. Applicant reserves the right to file a divisional application for further prosecution of these claims.

### *Claim Disposition*

Claims 1 - 25 are pending in the application. Claims 5 - 9 and 18 - 25 have been withdrawn from consideration. Claims 1-2, 10-11, and 14 - 15 have been rejected. Claims 3-4, 12 - 13, and 16 - 17 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims,

### *Claim Rejections - 35 USC § 102*

Claims 1-2, 10-11 and 14-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Dorri et al. U.S. Patent No. 5,721,523, hereinafter referred to as Dorri. Applicant respectfully traverses. The Examiner states:

"Dorri discloses a magnet for MRI. Applicants attention is directed to Fig. 2 and corresponding description. The magnet assembly features, a first set of turns 62, and a second set of turns 76, corresponding to a primary coil. A secondary or shielding coil is formed by a third set of turns 98 and a fourth set of turns 100. The third set of turns is radially outward and in "close proximity" to the first set of turns. Likewise the fourth set of turns is radially outward and in "close proximity" to the second set of turns. All windings are symmetrically disposed with respect to axis 68 and a midplane including point 88. Note that while Dorri does not specifically mention gradient coils, control unit, gradient amplifiers etc. the magnet described is intended for MRI where the presence of the above mentioned elements is customary in an imaging system.

Applicant respectfully contends that the explanation in the Office Action mischaracterizes the teachings of Dorri. To anticipate a claim under 35 U.S.C. §102, a single source must contain all of the elements of the claim. Lewmar Marine Inc. v. Barient, Inc., 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim." (emphasis added) Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ...claim." (emphasis added) Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

With regard to Claims 1-2, 10-11, and 14 - 15, and specifically with regard to claims 1, 10, and 14, Applicant respectfully contends that Dorri does not teach or disclose each element of the invention "arranged as in the claim". Specifically, Dorri does not teach or disclose, "a first set of turns having a first prescribed number of turns about an axis, the first set of turns being symmetrically positioned radially from the axis and longitudinally with respect to a mid plane perpendicular to the axis; a second set of turns having a second prescribed number of turns about the axis, the second set of turns being symmetrically positioned radially from the axis and

longitudinally with respect to the mid plane outward of the first set of turns;". Applicant notes that the Examiner relies on reference numerals 62 and 76 as the first and second set of turns respectively. Applicant respectfully contends that coil 62 of Dorri is not **symmetrically positioned ... longitudinally** with respect to the mid plane. Furthermore, coil 76 is also not **symmetrically positioned ... longitudinally** with respect to the mid plane. Furthermore, coil 76 is not **positioned outward** of the first set of turns, i.e., coil 62 as the Examiner suggests.

Similarly, Dorri does not teach or disclose, "a third set of turns having a third prescribed number of turns about the axis, the third set of turns being **symmetrically positioned radially from the axis and longitudinally** with respect to the mid plane in **close proximity to the first set of turns and outward** of the first set of turns; and a fourth set of turns having a fourth prescribed number of turns about the axis, the fourth set of turns being symmetrically positioned radially from the axis and longitudinally with respect to the mid plane in **close proximity to the second set of turns and outward** of the second and third sets of turns". Applicant notes that the Examiner relies on reference numerals 98 and 100 as the third and fourth set of turns respectively. Applicant respectfully contends that coil 98 of Dorri is not **symmetrically positioned ... longitudinally** with respect to the mid plane. Furthermore, coil 100 is also not **symmetrically positioned ... longitudinally** with respect to the mid plane. Furthermore, coil 98 is not **in close proximity to the first set of turns and outward** of the first set of turns, i.e., coil 62 as the Examiner suggests. Likewise, coil 100 is not **in close proximity to the second set of turns and outward** of the second set of turns, i.e., coil 76 as the Examiner suggests. In fact, Dorri, specifically teaches that coils 98 and 100 are disposed more toward the outside walls 90 and 96 respectively than the inner walls. Thus, purposefully placing coils 98 and 100 not in close proximity to the second set of turns i.e., coil 76. Therefore, because Dorri does not disclose or teach an element of the invention it cannot anticipate the Applicant's claims. Thus, Claims 1 - 2, 10 - 11, and 14 - 15 are allowable, the rejections are improper, and they should be withdrawn.

In view of the above discussion, Claims 2, 11, and 15 depend from Claims 1,

10, and 14 respectively whether directly or indirectly, and include all of the corresponding limitations thereof. Claims 1, 10, and 14 are not taught by Dorri, therefore, Claims 2, 11, and 15 cannot be taught by Dorri either. Thus, Claims 2, 11, and 15 are allowable, the rejections are improper and they should be withdrawn.

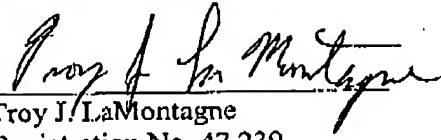
The arguments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims have not been amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicant is entitled has been surrendered. Allowance of the claims is respectfully requested in view of the above remarks. Moreover, no amendments are presented that alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection.

It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicant. In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully request the courtesy of a telephone conference to discuss any matters in need of attention.

No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 07-0845.

Respectfully submitted,

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